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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/039,706 | 11/09/2001 | Stephan Gutmann | PI/5-30958A/C1 | 5651 |

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12/30/2002

Thomas Hamilton
Syngenta Crop Protection, Inc.
Patent and Trademark Dept.
410 Swing Road
Greensboro, NC 27409

EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 12/30/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/039,706

Applicant(s)

GUTMANN, STEPHAN

Examiner

Venkataraman Balasubramanian

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Applicants' response, which included cancellation of claims 4-5, 10 and 12, amendment to claims 1-3 and 11, filed on 10/11/2002, is made of record.

Applicants' should note that although there is no direct instruction to cancel claims 4,5, 10 and 12, in view of applicants' response, which indicates these claims were cancelled and also intended cancellation shown in mark-up copy of the claims.

Claims 1-3 and 11 were earlier deemed as allowable. However in view of 112 issue raised by claim 11 and upon further consideration, the claims are deemed as not allowable as is. The following rejections apply:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The process claim 11 is indefinite as it recites the term "solvating agent" which can also include solvents other than what is positively recited in claim 1. It is not clear how one would be able to arrive at compound of formula I using solvent(s) other than the solvent embraced in L definition of claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Kristinsson US 4,931,439.

Kristinsson teaches 2,3,4,5-tetrahydro-3-oxo-4-[(pyridin-3yl)-methylenamino]-6-methyl-1,2,4-triazines which include the same compound –pymetrozone-, (as noted in the instant specification and cited in the Information Disclosure Statement) for the use as pesticides. See col. 1, formula I and note the definition of various variable groups. See col. 2-4 for preferred embodiments and process of making them. See examples of compounds made on col. 7-12. Especially see Example P.3 wherein Kristinsson teaches the process for making pymetrozone. Note use of ethanol as solvent, water and ether in the process of isolation of pymetrozone.

Instant specification on page 8 clearly admits that water-free and solvent-free pymetrozone take up water or a solvent from atmosphere or during mixing or grinding. This property of pymetrozone as noted by the applicants appears to be inherent property of the compound. Hence there is no reason to believe that the prior art pymetrozone, which was in contact with ethanol, ether and water would not do so and form hydrate/solvate with water and the solvents used.

Applicants have not shown that the prior art compound is devoid of hydrate and/or solvate. Hence this rejection is proper. See In re Best 195 USPQ 430. Note the following quote taken from In re Best 195 USPQ 430 : “ Where the patent Office has reason to believe that a functional limitation asserted to be critical for establishing

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novelty in the claimed subject matter, may, in fact, be an inherent characteristic in the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on". See also See In re Fitzgerald 205 USPQ 594; In re Grose 201 USPQ 57. See also 51 USPQ 2d 1301, Abbott Laboratories vs Geneva Pharmaceuticals regarding the crystalline form of a product.

Kristinsson also teaches that the said compound can be used in formulation with suitable solvents, which include those solvents claimed in the instant claims. See col. 5, lines 25- 45. Since the formulation as such is a solution, there is no distinction between using a hydrate or methanolate etc. of instant compound with the recrystallized product of Kristinsson.

There is no reason to believe that the instant formulation would behave differently from those of Kristinsson. Hence this rejection is applicable to use of the compound pymetrozone in formulation. Note In re Petering et al 133 USPQ 275; In Re Schaumann, 195 USPQ 5.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kristinsson US 4,931,439.

Teachings of Kristinsson as discussed in the above 102 rejection is incorporated herein.

Instant claims differ from teachings of Kristinsson in requiring several specific solvents for L of instant compound.

Kristinsson teaches use several solvents for the reactions to make the generic compounds. See examples on col. 7-12. Thus Kristinsson teaches equivalency of solvents used for the reactions in general. In addition, Kristinsson teaches use of several solvents for formulations. Thus it would be obvious for one trained in the art at the time of the invention, to select all the process parameters in the range taught by the reference including solvents recited therein for optimizing the process leading high purity product with desirable physicochemical characteristics as one would expect under similar operating conditions of process the purity of the product and its physicochemical characteristics would in the same range and would therefore expect resulting compounds (instant compounds) to possess the uses taught by the art in view of the equivalency teaching outline above.

Conclusion

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716.

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The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

V. Balasubramanian
Venkataraman Balasubramanian

12/23/2002